

Application No. 10/082,418
Reply to Office Action of August 2, 2004

D. REMARKS

Interview Summary

On October 29, 2004, Applicants' representative submitted an "Applicant Initiated Interview Form" to Examiner Knowlin via facsimile. Applicants' representative requested discussion of a proposed attached amendment to claim 1, 9, and 47 and requested clarification of the grounds of rejection for claims 2 and 22.

On November 1, 2004 at 10:00 AM EST, an interview was conducted via telephone between Amy Patillo, Applicants' Representative, and Examiners Knowlin and Matar. No exhibits were shown, nor demonstrations conducted.

Applicants' representative and the Examiner discussed claim 1, and in particular a proposed attached amendment to claim 1. Specifically, the prior art cited against claim 1 is the US Patent to Novak (U.S. Patent 4,266,098).

In particular, Applicant's representative proposed an amendment in advance to add an additional element to claim 1 of detecting an identity of a caller requesting use of a telephone line to place an outgoing call to distinguish claim 1 from Novak's system which detects the identity of the caller of an incoming call. Examiner Matar noted that the proposed amendment would require a new search of the art. In conclusion, no agreement with respect to the claims was reached. Applicants are filing this response with the amended claims for further review by the Examiner.

With respect to claim 22, Applicants' representative requested a clarification of where Novak teaches the "comparing" element of the claim. Examiner Matar noted that in view of the proposed amendments, Novak may no longer apply, so the issue was moot.

With respect to claim 2 and the other claims rejected under 103(a), Applicants' representative requested a clarification of where the Examiner articulated a suggestion or motivation for modifying the references used as grounds for the 103(a) rejection. Examiner Matar indicated that the rejection of claim 2 was not in proper 103(a) form. Applicants representative agreed to note the lack of articulation of this element required for proving a case of prima facie obviousness.
Docket # AUS920010849US1

Application No. 10/082,418
Reply to Office Action of August 2, 2004

35 USC § 102(b)

Claims 1, 8, 15, 22, 24, and 26 stand rejected under 35 U.S.C. §102(b) as being disclosed by Novak. (US Patent Number 4, 266,098) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed Cir. 1987). Furthermore the reference must be an enabling disclosure of each and every element as set forth in the claim. *In re Hoecksmas*, 158 USPQ 596, 600 (CCPA 1968); *In re LeGrive*, 133 USPQ 365, 372 (CCPA 1962). Applicants have amended claims 1, 8, 15, 22, 24, and 26 where Novak no longer anticipates these claims. Thus, Applicants respectfully request that the rejection be withdrawn and amended claims 1, 8, 15, 22, 24, and 26 allowed.

Claims 1, 8, and 15

With respect to claim 1, the Examiner cites Novak col. 1-2, lines 64-14 and col. 2 lines 53-68 as teaching the method of claim 1. Claim 1 currently reads:

1. **(Currently Amended)** A method for regulating use of a telephone line, comprising:

detecting an identity of a caller requesting use of a telephone line to place an outgoing call; and

only allowing use of said telephone line to place said outgoing call by said caller if a schedule for said telephone line indicates that said caller identity is currently allowed to place said outgoing call.

Applicants respectfully propose that Novak does not anticipate the invention of amended claim 1 because Novak does not teach expressly or inherently the elements of detecting an identity of a caller requesting use of a telephone line to place an outgoing call or only allowing
Docket # AUS920010849US1

Application No. 10/082,418
Reply to Office Action of August 2, 2004

use of the telephone line to place the outgoing call if a schedule for the telephone line indicates that the caller identity is currently allowed to place the outgoing call. Further, Novak does not enable these elements.

In general, Novak teaches "screening and processing incoming calls." (col. 1, lines 8-9) With reference to the first element of claim 1, the Examiner cites, col. 1, line 64-col. 2, line 14 of Novak, which teaches:

"Upon having his call answered, the caller would transmit, via the answering device 4 to the analog decimal converter 5 a predetermined code of one or more tones.

The analog to digital converter 5 would then convert the transmitted analog tones to digital form. Again, while in practice, any number of tones may be used for transmission of a code message, for illustrative purposes the inventor has chosen the use of a code consisting of a three-digit number.

This number would be compared, by processor 6 to numbers previously stored in memory 7. In the given example, decoded transmissions which are found to contain a three-digit number which exactly corresponds with a number previously stored in memory 7 by the device's user, as a number corresponding to that from which calls will be accepted, would also be sent by the processor 6 to a display 8."

With reference to the second element of claim 1, the Examiner cites col. 2, lines 53-68 of Novak which teaches:

"An operational example of the preferred embodiment follows. In this example the device is equipped with a clock 10, answering message unit 9 and an incoming message recorder 16 and a display decoder 11 with memory 12. In the example, the device's user, who will be called Adam Jones, wishes to accept calls from Mary Jones or John Doe at any time, John Smith only between the hours of 8 AM and 11 PM and no other calls at any time. He has assigned the following code number: 1-2-3 to Mary Jones, 2-2-2 to John Doe, and 3-3-3 to John Smith and has programmed processor 6 and its display decoder 11 to convert the code 1-
Docket # AUS920010849US1

Application No. 10/082,418
Reply to Office Action of August 2, 2004

2-3 so as to cause the display to read "Mary Jones," the code 2-2-2 to "John Doe," and 3-3-3 to "John Smith" and any other code to "unknown."".

In the teachings cited by the Examiner, Applicants respectfully propose that Novak merely teaches a method for allowing a user to screen incoming calls by requiring incoming callers to enter a code and further filtering the code through a schedule of allowed callers at particular times. Novak does not teach restricting use of a telephone line to place outgoing calls according to the caller identity and according to a schedule of callers currently allowed to place outgoing calls from the telephone line. In contrast, amended claim 1 teaches "detecting an identity of a caller requesting use of a telephone line to place an outgoing call" and "only allowing use of the telephone line to place said outgoing call by the caller if a schedule for the telephone line indicates that the caller identity is currently allowed to place the outgoing call." Applicants note that the amendments to claim 1 are supported throughout the specification and in particular with reference to page 27, line 27- page 29, line 10.

The Examiner also rejects system and program product claims 8 and 15 on the same grounds as the rejection of method claim 1. Applicants have amended system and program product claims 8 and 15 to reflect the amendments to claim 1.

Therefore, because Applicants have amended claims 1, 8, and 15 to overcome the teachings of Novak, Applicants respectfully request allowance of amended claims 1, 8, and 15.

Claims 22, 24 and 26

With respect to claim 22, the Examiner cites Novak col. 3 , lines 1-24 as teaching the method of claim 22. Claim 22 currently reads:

22. **(Currently Amended)** A method for regulating use of a telephone line requested by a plurality of parties, comprising:

detecting an identity of a first caller requesting use of a telephone line to place a first outgoing call; and

Docket # AUS920010849US1

Application No. 10/082,418
Reply to Office Action of August 2, 2004

comparing said identity of said first caller with a schedule for at least one other caller concurrently requesting use of a telephone line to place a second outgoing call; and

only allowing said first caller use of said telephone line to place said first outgoing call if a schedule for said telephone line indicates that said first caller currently has priority for use of said telephone line.

Applicants respectfully propose that Novak does not anticipate the invention of amended claim 22 because Novak does not teach expressly or inherently detecting an identity of a caller requesting use of a telephone line to place an outgoing call, comparing the identities of multiple callers attempting to concurrently place outgoing calls via the same telephone line, and only allowing a caller to place an outgoing call if the schedule for the telephone line gives the caller priority to use the telephone line. Further, Novak does not enable these elements.

In general, Novak teaches "screening and processing incoming calls." (col. 1, lines 8-9) With reference to the elements of claim 22, the Examiner cites, col. 3, lines 1-24 of Novak which teaches:

"All callers to Adam Jones would receive the following message: "Hello, this is Adam Jones. Please transmit your code." An uninformed or uncoded caller would either send no code or a guess. In either case display 8 would show the notation "unknown" and the bell 3B would not ring. Such callers would, via transmittal of a type 3 message by message sender 9, be invited to leave a message with message recorder 16.

Mary Jones, however, would send her code (1-2-3) which would be found by the processor 6, in search its memory 7, to be a call acceptable at all times. Thus, regardless of the time at which her call was received, bell 3B would be made to ring and display 8, via decoder 11 and its memory 12, would show the notations "Mary Jones." Similarly, the code 2-2-2 received at any time will be converted to display "John Doe" and also cause bell 3B to ring.

Docket # AUS920010849US1

Application No. 10/082,418
Reply to Office Action of August 2, 2004

The code 3-3-3, however, will ring the bell and be displayed as "John Smith" only if received during the preset hours (8AM to 11 PM). At all other times, the bell will not ring, although Mr. Smith would, via message type 2, "hear" it ring for a preset number of times before being informed, via a type 3 message, that Adam Jones was unavailable."

In the teachings cited by the Examiner, Applicants respectfully propose that Novak merely teaches a method for allowing a user to screen incoming calls by requiring incoming callers to enter a code and further filtering the code through a schedule of allowed callers at particular times. Novak does not teach restricting use of a telephone line to place outgoing calls according to the caller identity and according to a schedule of callers currently allowed to place outgoing calls from the telephone line. Further, Novak does not teach comparing the priority of multiple callers concurrently requesting to place an outgoing call from a telephone line and only allowing access to place an outgoing call to the caller with the highest priority. In contrast, the amendments to claim 22 mirror the amendments of claim 1 that distinguish that an identity of a caller attempting to place an outgoing call is detected, which is not taught by Novak's teaching of detecting a code entered by a caller of an incoming call. Further, in contrast, claim 22 teaches comparing the priority of multiple callers attempting to use a telephone line and only allowing the caller with the highest priority to use the telephone line according to a schedule, which is not taught by Novak's teaching of detecting a code entered by a caller of an incoming call and determining whether the schedule currently allows calls to ring through for the code. Applicants note that the amendments to claim 22 are supported throughout the specification and in particular with reference to page 38, line 15- page 39, line 13.

The Examiner also rejects system and program product claims 24 and 26 on the same grounds as the rejection of method claim 22. Applicants have amended system and program product claims 24 and 26 to reflect the amendments to claim 22.

Therefore, because Applicants have amended claims 22, 24, and 26 to overcome the teachings of Novak, Applicants respectfully request allowance of amended claims 22, 24, and 26.

Docket # AUS920010849US1

Application No. 10/082,418
Reply to Office Action of August 2, 2004

35 USC § 103(a)

Claims 2-7, 9-14, 16-21, 23 and 25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Novak in view of King et al. (US Patent Number 5,872,841). Applicants first note the above proposition that amended claims 1, 8, 15, 22, and 24 are not taught by Novak, and therefore as dependent claims of allowable subject matter, claims 2-7, 9-14, 16-21, 23 and 25 should also be allowed. Applicants second note that the Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. Because the Examiner does not carry the burden of proving a prima facie case of obviousness for claims 2-7, 9-14, 16-21, 23, and 25, the rejection should be withdrawn and the claims should be allowed.

First, in establishing a prima facie case of obviousness under 103(a), there must be some suggestion or motivation to modify the references. In *re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Applicants note that in the rejections of claims 2-7, 9-14, 16-21, 23 and 25, the Examiner describes the element taught by King et al. that is not taught by Novak et al, but does not articulate, with regard to any of these claim rejections, a suggestion or motivation to modify the references. Thus, where the Examiner does not articulate a suggestion or motivation to modify the references, the Examiner does not meet the requirements of establishing a prima facie case of obviousness under 103(a) and therefore Applicants respectfully request allowance of these claims.

Second, Applicants note that claims 3-7, 10-14, and 17-21 have been amended to reflect the amendments to independent claims 1, 8, and 15 and to reflect proper antecedent basis. Applicants respectfully request entry and allowance of amended dependent claims 3-7, 10-14, and 17-21.

Third, with respect to claims 4, 11, and 18, Applicants respectfully assert that the Examiner fails to establish prima facie obviousness under 103(a). In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. In *re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). The Examiner suggests that Novak discloses all of the limitations of claims 4, 11, and 18 except for "detecting a subject for a call requested by said caller; and filtering said schedule according to said subject for said call." The Examiner notes that King, teaches these elements where "the subject of the Docket # AUS920010849US1

Application No. 10/082,418
Reply to Office Action of August 2, 2004

call could be a meeting” as described in Table 1 and col. 5, lines 20-36. [Office Action, p. 4]
Applicants note that Table 1 indicates the current calendar events of a callee, where “meeting” is a designator for a scheduled event of the callee, indicating that the callee is not available during the time slot, not the subject of the call. Further, Applicants note that col. 5, lines 20-36 describes a method for scheduling a telephone call between two parties in the calendar by searching for mutually agreeable available time slots, but does not describe detecting a subject of a call requested by the caller. Thus, Applicants respectfully assert that neither Table 1 or col. 5, lines 20-36 teach “detecting a subject for a call requested by said caller” or “filtering said schedule according to said subject for said call.” Therefore, Applicants respectfully propose that the Examiner does not meet the burden of showing the obviousness of making the combination because the claimed invention is not taught by combining the references.

Docket # AUS920010849US1

Application No. 10/082,418
Reply to Office Action of August 2, 2004

Conclusion

In view of the foregoing, Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

 on 11/2/2004

Amy J. Pattillo
Attorney for Applicants
Registration No. 46,983
P. O. Box 161327
Austin, Tx 78716
(512) 402-9820 (phone & fax)

Docket # AUS920010849US1